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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/978, 637 11/25/97 RABBANI

E ENZ-53 (DIV5)

HM12/1109

EXAMINER

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527 MADISON AVENUE 9TH FLOOR  
NEW YORK NY 10022

SCHMIDT, M

ART UNIT	PAPER NUMBER
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1635

DATE MAILED:

11/09/99

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.	Applicant(s)
08/978,637 Rabanne et al.	
Examiner Schmidt	Group Art Unit 1035

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on 8/23/99.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 245-313 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 245-313 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

Art Unit: 1635

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 245-313 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the same reasons of record set forth in the Official action mailed 02/16/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant's response is non-responsive to the arguments made in the first Official action.

2. Claims 245-289 and 299-313 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the same reasons of record set forth in the Official action mailed 02/16/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant's response provides only an assertion that an ordinarily skilled artisan, armed with the specification, could practice the invention without undue experimentation. This assertion, without any supporting evidence, fails to overcome the *prima facie* case of lack of enablement.

Art Unit: 1635

***Claim Rejections - 35 USC § 102***

3. Claims 265-298 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullenger et al., for the same reasons of record set forth in the Official action mailed 02/16/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant does not address specifically what elements lack material identity between the invention taught by Sullenger et al. and the compositions of the instant invention as broadly claimed.

4. Claims 245-249, 251, 255, 258-261 and 264 rejected under 35 U.S.C. 102(b) as being anticipated by Huse et al., for the same reasons of record set forth in the Official action mailed 02/16/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant does not address specifically what elements lack material identity between the invention taught by Huse et al. and the compositions of the instant invention as broadly claimed.

5. Claims 245-264 and 299-313 are rejected under 35 U.S.C. 102(e) as being anticipated by Giri et al., for the same reasons of record set forth in the Official action mailed 02/16/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant does not address specifically what elements lack material identity between the invention taught by Giri et al. and the compositions of the instant invention as broadly claimed.

Art Unit: 1635

6. Claims 245-313 are rejected under 35 U.S.C. 102(b) as being anticipated by DeYoung et al., for the same reasons of record set forth in the Official action mailed 02/16/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant does not address specifically what elements lack material identity between the invention taught by De Young et al. and the compositions of the instant invention as broadly claimed.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

Art Unit: 1635

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *George Elliott, Ph.D.* may be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



George C. Elliott, Ph.D.  
Supervisory Patent Examiner  
Technology Center 1600

M. M. Schmidt  
November 8, 1999